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PFIZER INC  
10555 SCIENCE CENTER DRIVE  
SAN DIEGO CA 92121

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**SEP 08 2006**

**OFFICE OF PETITIONS**

In re Application of :  
Stjernschantz et al. : DECISION ON APPLICATION  
Application No. 10/723,140 : FOR  
Filed: November 25, 2003 : PATENT TERM ADJUSTMENT  
Attorney Docket No. PC30246J :

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705" filed July 31, 2006. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b)(3)(B)(i) be corrected from two hundred forty-three (243) days to two hundred forty-eight (248) days.

The application for patent term adjustment is **DISMISSED**.

On April 27, 2006, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 243 days. On July 31, 2006, applicants timely<sup>1</sup> submitted an application for patent term adjustment (with required fee), asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance was 248 days. Applicants dispute the reduction of 5 days associated with the filing of a response after non-final on April 3, 2006. Applicants state that they mailed the Response to the December 29, 2005 Office action on March 29, 2006 via the United States Postal Service First Class Mail. Further, applicants argue that this Response was timely filed as it was within the requisite 3-month time limit and included a signed Certificate of Mailing.

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<sup>1</sup> PALM records indicate that the Issue Fee payment was also received on July 31, 2006.

Applicants state that the allowed application is not subject to a terminal disclaimer.

Applicants are incorrect. 37 CFR § 1.704(b) provides that:

With respect to the grounds for adjustment set forth in §§ 1.702(a) through (e), and in particular the ground of adjustment set forth in § 1.702(b), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

Moreover, 37 CFR 1.703(f) provides that the date indicated on any certificate of mailing or transmission under 37 CFR 1.8 shall not be taken into account in this calculation. The date indicated on a certificate of mailing is used only to determine whether the correspondence is timely (including whether any extension of the time and fee are required) so as to avoid abandonment of the application or termination or dismissal of proceedings. The actual date of receipt of the correspondence in the Office is used for all other purposes. See 37 CFR 1.8(a). Thus, while the date indicated on any certificate of mailing or transmission under 37 CFR 1.8 will continue to be taken into account in determining timeliness, the date of filing (37 CFR 1.6) will be the date used in a patent term adjustment calculation. Applicant may wish to consider the use of the "Express Mail Post Office to Addressee" service of the United States Postal Service (37 CFR 1.10) or facsimile transmission (37 CFR 1.6(d)) for replies to be accorded the earliest possible filing date for patent term adjustment calculations. Alternatively, applicant may choose to mail

correspondence with sufficient time to ensure that the correspondence is received in the Office (and stamped with a date of receipt) before the expiration of the three-month period. See MPEP 2731.

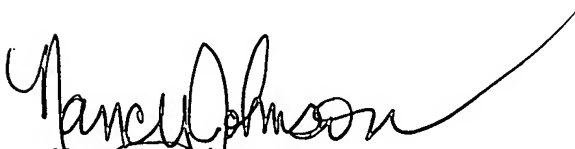
Accordingly, pursuant to § 1.704(b), the period of adjustment was properly reduced by 5 days, the number of days, beginning on March 30, 2006, the day after the date that is three months after the date of mailing of the non-final Office action, and ending on April 3, 2006, the date of filing of the reply.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is two hundred forty-three (243) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The Office will forward the application to the Office of Patent Publication so that the application can be issued in a timely manner.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.



Nancy Johnson  
Senior Patents Attorney  
Office of Petitions